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Atty Dkt. No.: RIGL-009CON
USSN: 09/724,380

TECH CENTER 1600/2900
REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 3, 8-10 and 18 are pending after entry of the amendments set forth herein.

Claims 8-10 are objected to. Claim 18 is allowed.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

No new matter has been added.

Information Disclosure Statement

An Information Disclosure Statement was mailed in the present application on November 21, 2002. Applicants respectfully request the Examiner consider the references cited, and indicate such consideration by returning a copy of the initialed PTO/SB/8A form with the next action.

Obviousness-type Double Patenting

Claim 3 was rejected under the doctrine of obviousness-type double patenting as being unpatentable over:

- 1) claims 18, 19, 27 and 30-36 of co-pending U.S. application serial no. 10/104,611 ('611) in view of Draper et al. (US 5,248,670); and
- 2) claims 1, 6 and 14 of US 5,738,985 ('985) in view of Draper et al.

Rejection based on '611 claims

Applicants note that the obviousness-type double patenting rejection over the '611 application was a provisional rejection, since the '611 application has not yet issued. Applicants respectfully request that this rejection be withdrawn and, if applicable, the rejection be applied against a claim of the later-filed '611 application.

Rejection based on '985 claims

Without conceding as to the correctness of the rejection, applicants submit herewith a Terminal Disclaimer over the '985 patent. Applicants respectfully request that this rejection be withdrawn.

In addition, the Office Action states that the '985 patent would form the basis for rejection under §103(a) if the commonly assigned case qualifies as prior art under §102(f) or §102(g), and the conflicting inventions were not commonly owned at the time the invention in this application was made. Thus, the Office required that applicants either show that the conflicting invention were commonly owned at the time the invention the present application was made or to name the prior inventor of the conflicting subject matter.

The present application is a continuation of U.S. application serial no. 08/925,156, filed September 8, 1997 (now US 6,156,496), which is a divisional of U.S. application serial no. 08/221,816 ('816), filed April 1, 1994, which is now issued as the '985 patent. The presently claimed invention was made at the time of, and disclosed in, the '816 application.

The '816 application, which led to the '985 patent was assigned by the inventors to Ribogene, Inc. (recorded 09/01/94, Reel/Frame 7119/0098). The '985 patent was subsequently assigned from Ribogene, Inc. to Questor Pharmaceuticals, Inc. ("Questor") (recorded August 13, 2001, Reel/Frame 012075/0136) and then assigned from Questor to Rigel Pharmaceuticals, Inc. (recorded August 15, 2001, Reel/Frame 012075/0387). Copies of these assignments are enclosed.

Thus, the presently claimed invention and the invention claimed in the '985 patent were commonly owned at the time the invention in the present application was made.

Therefore, this rejection can be withdrawn.

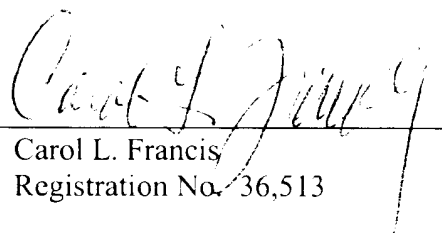
Conclusion

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-009CON.

Respectfully submitted,
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Date: February 24, 2003

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